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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,213	01/22/2004	Christine Rondeau	05725-0384-01	2722
22852	7590	05/26/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			EINSMANN, MARGARET V	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,213	Applicant(s) RONDEAU, CHRISTINE	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/287,176.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cotteret in view of Mockli.

Cotteret, U.S. Patent No. 5,735,908, teaches that the addition of a cationic or amphoteric substantive polymer to oxidation dye compositions which contain a p-phenylenediamine of formula (I) and preferably a coupler results in enhanced selectivity, increased intensity and uniformity, and improved fastness properties, see col. 1, line 50-col. 2, line 18.. Cotteret's preferred polymers include those as claimed, e.g. Polyquaternium-24, -37, -32 and -35, and Merquat 280, wherein the polymers are present in the claimed amounts, see col. 3, line 26-col. 4, line 60. Cotteret also teaches couplers as claimed as preferred for addition to such compositions, and that such compositions may contain direct dyes, see col. 5, lines 39-52. Cotteret also teaches that direct dyes may be added to the dyeing compositions, and that their dyes may be chosen from azo, nitro and anthraquinone dyes. See col 5 lines 53 et seq as well as col 6 lines 5 and 6. Cotteret fails to teach the addition of the specific direct dyes as claimed.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6), which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4-page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair

Art Unit: 1751

dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair in the claimed forms which contain an oxidation base and cationic dye as claimed in the claimed amounts, a coupler in the claimed amounts, and a cationic or amphoteric polymer, oxidants, other direct dyes, and solvents as claimed, wherein the compositions may have pH's as claimed and may be forms as claimed, and wherein the compositions may be applied to hair in dyeing methods as claimed, because such compositions, methods fall within the scope of Cotteret's teachings. It would have been obvious to those skilled in the art to select a cationic dye as taught by Mockli as the direct dye in the composition of Cotteret because Mockli teach that said dyes are compatible with the cationic polymers, for example the polyquaternium polymers, that Cotteret uses, and Cotteret teaches that the claimed polymers result in various improved properties such as improved selectivity when used in oxidation dyeing compositions. Cotteret applies the dyes in the methods claimed, premixing with hydrogen peroxide before applying to the hair. See examples. It would have been obvious to one having skill in the art to provide the compositions in the kit as claimed in claim 40, since that is how oxidation hair dyes are ordinarily

Art Unit: 1751

provided to the consumer, in order to have a premeasured amount of dye and oxidant to mix directly before application.

Claims 1-23, 32-36 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Corp in view of Mockli.

Kao Corp, DE 29512302, teaches compositions for dyeing or toning human hair which comprise a direct dye and a hydroxyalkyl guar gum or a quaternary salt thereof. See English language abstract. The direct dyes include cationic dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57 (which read on the claimed additional direct dyes), and may be present in the claimed cationic dye amounts. See page 3 of the English translation for the dyes lines 20 and page 6 line 4. Kao Corp teaches that the compositions may also contain conditioning polymers in the claimed amounts, including specifically claimed polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidones. See page 4 of the translation fourth paragraph. The compositions are aqueous, may have the pH as claimed, and may be present in the claimed amounts. See English translation page 2 and page 5. Kao Corp exemplifies various compositions which contain basic direct dyes in combination with a cationic conditioning polymer which are applied to hair in dyeing methods as claimed. See the examples on page 5 of the translation. Kao does not teach cationic direct dyes of the claimed formulae.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6), which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4-

Art Unit: 1751

page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate an aqueous composition in the claimed forms for dyeing hair which comprises a cationic dye in the claimed amounts and a cationic polymer as claimed in the claimed amounts, wherein the composition has a pH as claimed and is applied to hair in dyeing methods as claimed, because such dyeing compositions and methods fall within the scope of those taught by Kao Corp. Furthermore, Kao Corp's teaching that the claimed polymers are used to condition the hair would have motivated those skilled in the art to add such polymers to the patentee's compositions in order to get improved conditioning results. It would have been obvious to those skilled in the art at the time the invention was made to at least partially substitute the cationic dyes in Kao's compositions with a cationic dye as claimed because Mockli teaches that the claimed dyes result in improved color strength and fastness properties as compared to the dyes used by Kao Corp. Mockli also

Art Unit: 1751

teaches that the dyes may be mixed with customary hair dyeing additives, including cationic conditioning polymers, suggesting their compatibility in Kao Corp's compositions which contain substantive polymers as claimed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,592,633. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both applications are directed to compositions, process and kits for dyeing keratinous fibers comprising cationic direct dyes and polymers. The group of polymers in each case are substantially equivalent or overlapping; the claimed dyes in each case are the same or at least position isomers. Accordingly one skilled in the art would know that the claimed compositions, processes and kits are obvious variants.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1751

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for defining R1, R2 and R6 as "Optionally oxygenated or nitrogenous heterocyclic."

Claims 1 and 13 contain trademarks "Polyquaternium 10" and "Polyquaternium 24." A trademark or trade name should be used to identify a source of goods, not the goods themselves. Where a trademark is used in a claim to identify a particular material or product, that claim does not comply with the requirements of 35 U.S.C 112 second paragraph.

Claims 37-40 are indefinite because a claim cannot define a component in a composition by referring to that component as defined in a previous claim unless that claim further limits the previous claim. In this case, claim 37 does not further limit claim 1. Claim 39 is not properly dependent on claim 37 because it recites a composition while claim 37 defines a method.

The above rejections are substantially the same as applied in the first action on the merits and the final rejections in the parent case 09/287,176. The obviousness rejections were affirmed by the Board of Patent Appeals and Interferences on November 23, 2003. In a conversation with Thalia Warnement on May 13, 2004 a request was made to the examiner for a non-final action to give applicants time to

Art Unit: 1751


prepare comparative testing to possibly overcome the obviousness rejections of record.

Accordingly this action is not a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret Einsmann
Primary Examiner
Art Unit 1751

May 18, 2004